

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK M. TETERUD and PAUL EMERSON

Appeal No. 2005-0666
Application 10/044,678

ON BRIEF

Before JERRY SMITH, RUGGIERO and DIXON, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-6, which constitute all the claims in the application.

The disclosed invention pertains to a communication chip for a head of a disk drive system.

Representative claim 1 is reproduced as follows:

1. A communication chip for a head comprising:

a first row of connection points positioned along at least one edge of said communication chip;

a second row of connection points positioned along at least one edge of said communication chip and behind said first row;
and

said communication chip being connected to said head through said first and second rows of connection points.

The examiner relies on the following references:

Contreras et al. (Contreras)	5,774,291	June 30, 1998
Dandia et al. (Dandia)	6,246,121	June 12, 2001

Claims 1-6 stand rejected under 35 U.S.C. § 103(a)¹. As evidence of obviousness the examiner offers Contreras in view of Dandia.

Rather than repeat the arguments of appellant or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into

¹ The rejection of claims 1-6 under 35 U.S.C. § 102 has been withdrawn by the examiner [answer, page 3].

consideration, in reaching our decision, the appellant's arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-6. Accordingly, we affirm.

Appellant has made no separate arguments with respect to any of the claims on appeal. Since appellant has failed to argue the separate patentability of the claims, all contested claims stand or fall together. See In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Accordingly, we will consider the rejections against independent claim 1 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual

determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,

223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052; 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

With respect to representative claim 1, the examiner finds that Contreras teaches the claimed invention except that Contreras fails to explicitly disclose the arrangement of the connection points in the form of first and second rows. The examiner cites Dandia as teaching a generic bump pattern on a semiconductor chip. The examiner finds that it would have been obvious to the artisan to provide the circuit board of Contreras with connection points in the form of first and second rows as taught by Dandia [answer, pages 4-5].

Appellant argues that Contreras does not disclose or suggest the presently claimed invention. Appellant also argues that Dandia does not disclose or suggest the presently claimed invention because Dandia does not disclose a read channel system or a head. Appellant then simply asserts the advantages of the claimed invention [brief, pages 4-5].

The examiner responds that appellant has attacked each reference individually and has not responded to the collective teachings of the applied prior art. The examiner also explains again how the claimed invention is rendered unpatentable by the collective teachings of Contreras and Dandia [answer, pages 5-8].

We will sustain the examiner's rejection of claims 1-6 because appellant has failed to provide a persuasive argument in response to the rejection. Appellant's arguments in the brief essentially amount to nothing more than an assertion that neither Contreras nor Dandia individually discloses the claimed invention. The rejection, however, is not based on anticipation. Instead, the rejection is based on the collective teachings of the applied references. Appellant has failed to rebut any of the examiner's findings with respect to the obviousness of combining the teachings of Contreras with Dandia to arrive at the claimed invention. Since we find that the examiner has at least established a prima facie case of obviousness, and since appellant has offered no arguments in rebuttal to the rejection as formulated by the examiner, then we find that this record supports the examiner's rejection.

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In summary, we have sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-6 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

Joseph F. Russo
JOSEPH F. RUG

JOSEPH F. RUGGIERO
Administrative Patent Judge

[Handwritten signature]

JOSEPH L. DIXON
Administrative Patent Judge

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